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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,887	01/02/2002	Alan E. Thomas	AET1P001R2	5949

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EXAMINER

MULLEN, THOMAS J

ART UNIT	PAPER NUMBER
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2632

DATE MAILED: 12/10/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/050,887

Applicant(s)
Thomas

Examiner
Thomas J. Mullen

Art Unit
2632



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19 and 20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

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1. Parent reissue application 09/137,960 is noted. In accordance with 37 CFR 1.177 and MPEP 1451, both the parent reissue application and this reissue application must be amended to contain in the first sentence of the specification a notice identifying the other application by relationship (e.g. parent/child), serial number and filing date. In the parent application, this will require a Certificate of Correction since that application is now patented.
2. Claims 19-20 have been added to this application, but are not in compliance with 37 CFR 1.173 and MPEP 1453; i.e., the entire text of any “added” claims must be underlined, since they are considered “additions” to the patent.
3. Claims 19-20 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In parent application 08/158,989, claims 26 and 29 were rejected by the examiner and subsequently cancelled by applicant. Claim 29 of the parent application (incorporating the limitations of claim 26) differs from present claims 19 and 20 only in the following ways: (1) the present claims recite sensing or monitoring infrared energy “within (a) predetermined area”; (2) the present claims recite filtering out infrared energy “not within a predetermined frequency range”; (3) the parent claim 29 recited “converting the infrared energy into electrical signals”

prior to the filtering step (see lines 3-4 of the incorporated claim 26), i.e. “the filtered energy signals” were defined as “filtered electrical signals”; and (4) the parent claim 29 recited a “plurality” of infrared sensors. Thus, present claims 19 and 20 are “narrower” than parent claim 29 due to items (1) and (2), and “broader” than parent claim 29 due to items (3) and (4).

However, items (1) and (2) are considered inherent aspects of the method set forth in parent claim 29, and thus do not truly “narrow” the surrendered subject matter of parent claim 29, because:

(1) any energy detector (such as the “infrared sensors” of claim 29, as used in step (a) of incorporated claim 26) is implicitly defined or limited by the operational range (i.e. maximum distance) over which it may “detect” at least a predetermined level of the energy, i.e. the preset (or settable) sensitivity of the detector, and this operational range/maximum distance inherently constitutes a “predetermined area” of detection with respect to the location of the detector(s); and (2) in producing filtered electrical signals “corresponding to a fire” (as in step (c) of incorporated claim 26), it is inherent that filtering the infrared energy (or corresponding electrical signals) will involve the filtering out of infrared energy frequencies (or corresponding electrical signal components) which are not associated with “fire”, i.e. it is inherently necessary to filter out those electrical signal components which correspond to infrared energy that is “not within a predetermined frequency range” indicative of a “fire”.

Therefore, present claims 19 and 20 are considered equivalent to, or broader than, parent claim 29 (incorporating claim 26) in every respect, such that claims 19 and 20 are “recapturing” surrendered subject matter.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odashima in view of McMenamin.

Note in Fig. 3 of Odashima, light receiving (infrared) sensors 19 (col. 3, lines 7-12); "infrared-ray-passing" filter 15 (col. 3, line 5); and "predetermined area" DA (col. 3, lines 13-16). The location of the fire within the predetermined area is determined by appropriately processing the filtered energy signals from the sensors, in particular by receiving an output from an "adjacent two of the photo detectors" (see Fig. 4, col. 5, lines 54-68 and col. 6, lines 19-21), so as to appropriately direct a fire-extinguishing nozzle toward the fire. While Odashima fails to explicitly teach that filter 15 (and/or the sensors 19 themselves) filters out infrared energy "not within a predetermined frequency range", Odashima does teach "discriminating...the infrared rays of fire flames from those of other infrared ray sources", col. 2, lines 8-9; i.e., Odashima provides a motivation to filter out infrared energy not within a predetermined frequency range, since this would either simplify the processing arrangement required in Fig. 4 that distinguishes a "fire" from other sources of infrared energy, or just improve the performance of the existing processing arrangement by filtering out as many false signals as possible. McMenamin discloses a fire detector which senses infrared energy, note sensor 10 and amplifier/filter 14 which passes a "frequency range...preferably from about 5 (Hz) to about 20 (Hz)" (col. 2, lines 59-63), and thus implicitly "filters out" infrared energy not within this frequency range. Therefore, it would have been obvious to one of ordinary skill in the art to use the particular filter taught by McMenamin in the system of Odashima in order to provide the above-mentioned advantages and thus satisfy the motivation provided by Odashima.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The art cited by applicant (which includes the art cited in the parent application) is made of record.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Mullen whose telephone number is (703) 305-4382. The examiner can normally be reached on Mon-Thur from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Hofsass, can be reached on (703) 305-4717.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:


Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

T. Mullen
December 9, 2002


Thomas J. Mullen, Jr.
Primary Examiner
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